

### REMARKS

Claims 1-29 are pending in this application. Claims 1-29 stand rejected. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Paragraph 1 of the Office Action responds to Applicant's arguments presented in the Response of May 9, 2003. Applicant disagrees with the Examiner's response. Applicant still asserts that there is no suggestion to combine the references in the background of the invention as stated by the Examiner. Applicants find no allegation of an admitted problem in our background section as set forth by the Examiner. The background of the invention merely recognizes the problem in the prior art which includes leakage currents and deterioration in the input signals to the devices under test ("DUT"). This recognition of a problem is not a suggestion to combine the prior art with any other reference. Thus, there would be no reason to combine the prior art, referred to in the background of the invention (the AAPA), with the Zamborelli reference (U.S. Patent No. 5,172,051).

The Examiner then asserts that in Figure 1 of '051 Patent a signal is being transmitted in both ways, one from the tester to the DUT and the other from the DUT back to the tester. As shown in Figure 1, the probe tip 102 is connected to an appropriate circuit contact point. The signal is then detected by the probe tip 102, transmitted through the probe apparatus 100, and output to an electronic test instrument 150. See, Zamborelli, column 4, lines 1-6. There is no disclosure that any signal is provided from the test instrument 150 to the circuit under test 104. In fact, the only transmission flows from the DUT to the test equipment and it would be improper to use Figure 1 to suggest that a signal flows from the test equipment to the DUT. Thus, the Zamborelli probe is a

different device than the tester that is the subject of the present claims, which provides a signal to a device under test.

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Figures 1-3 in view of Zamborelli. Applicant requests reconsideration and withdrawal of this rejection.

The Office Action has failed to show a motivation in the cited references for combining the AAPA with the device shown in Zamborelli. M.P.E.P. § 2143. Absent a showing of such a motivation, a prima facie case of obviousness cannot be made. As such, if the Examiner persists in stating that such motivation is known, Applicant requests that the Examiner set forth a reference which shows such a motivation or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art and that one with ordinary skill in the art would be motivated to combine such knowledge with Zamborelli so that Applicant has the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03

Simply because information is well known does not make it obvious to combine that information with any reference. The Office Action must explain the reasons why one of ordinary skill in the art would be motivated to select the references or teachings and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). A principle must be identified, known by those with ordinary skill in the art, that suggests the claimed invention. *Id.* Inventions are frequently the process of combining prior art in a nonobvious manner. *Id.*

The Office Action has failed to show a motivation in the cited references for combining the testing apparatus disclosed in Figures 1-3 of the present application with Zamborelli. The Office Action asserts that it would have been obvious to combine the

AAPA with Zamborelli for the purpose of reducing in stray capacitance and increasing the probe bandwidth. However, this is not the result achieved by the present invention.

The present invention does not seek to reduce stray capacitances. Thus, reducing strong capacitance this would not motivate to combine Zamborelli with Applicant's admitted prior art. The problem solved by the present invention is to reduce the affect of leakage currents and deterioration in the input signals to the semiconductor devices under testing. One seeking to solve the problem of the prior art, as outlined in the specification, would not look to the Zamborelli which is solving an entirely different problem for a different device. Further, Applicant has recognized a problem in the prior art and solved such problem present in the prior art with the present invention.

The probe disclosed in Zamborelli is different than the device that is the tester of the subject of the present invention. The configuration of the present invention reduces the affect of leakage currents as well the deterioration in the input signals to semiconductors under test. Thus, the present invention allows for inspecting semiconductor devices having common drive wiring.

As discussed above, the probe in Zamborelli merely transmits a signal detected by the probe and transmits the detected signal to an electronic test instrument. This is not analogous to Applicant's explicitly recited apparatus which provides a signal for simultaneously inspecting a plurality of semiconductor devices.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the arrangement of components disclosed in Figures 1-3 in light of Zamborelli. As a result, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of

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obviousness with respect to claims 1-29 and that the objection to those claims should be withdrawn.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

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